| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/828,195 | 04/09/2001 | Sanjiv (Sam) K. Agarwal | | 3664 |

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| EXAMINER |
|---|
| GAUTHIER, GERALD |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2645 | |

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 August 2003*.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.      This application currently names joint inventors.  In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary.  Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

3.      **Claims 1-7, 10 and 16-20** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cohn et al. (US 5,982,956) in view of Fortman et al. (US 5,987,100).

Regarding **claim 1**, Cohn discloses a Network-based multimedia

communications and directory system and method of operation (column 1, lines 19-23),

(which reads on claimed "a network messaging system (24 on  FIG. 1) that is capable of

receiving messages (column 7, line 23 "a wide variety of messages sources") from

worldwide enterprises' applications (26, 28 and 34 on FIG. 1) and in various formats")

(column 7, lines 15-42) [The multimedia network-based communication system capable

of receiving messages from the telephone network and from a data network and over

the world wide web in voice mail, facsimile and email formats].

Cohn discloses receiving a wide variety of messages from different applications

but fails to disclose receiving a wide variety of messages from individuals in various

format.

However, Fortman teaches receiving a wide variety of messages (column 4, line

53 "voice mail" and line 61 "ADSI mail') from individuals (column 4, line 54 "the caller")

in various formats (column 4, lines 50-67) [The universal mail box receives messages

from caller in voice mail format and in ADSI mail format].

It would have been obvious to one of the ordinary skill in the art at the time the

invention was made to use a wide variety of messages from individuals in various

format of Fortman to modify the network-based multimedia communications of Cohn.

The modification of the invention would offer the capability of a wide variety of

messages from individuals in various format such as the subscriber would retrieve and

send response to a message in a format independent of the store or retrieve format.


Regarding **claim 2**, Fortman teaches unique methods of providing a two-way

communication by the recipients to acknowledge receipt of the messages and/or to

execute commands remotely (column 8, lines 6-30) [The subscriber is able to respond

to the message retrieved as an acknowledgement of receiving the message by the

system providing a two-way communications to the subscribers].


Regarding **claim 3**, Cohn discloses unique methods of providing automatic

escalation of delivery of messages (column 10, lines 50-66) [The communication

system provide a large amount of virtual storage for large scale messages for providing

bulletin boards services].


Regarding **claim 4**, Fortman teaches unique methods of scalability, efficiency

and reliability (column 7, lines 5-19) [The universal receives the messages from the

caller for scalability, sends messages to service provider to analyze the messages for

caller information for efficiency and notifies the subscriber in its profile format for

reliability].


Regarding **claim 5**, Cohn discloses unique methods for automatic directory

lookups for broadcast (group) messaging (column 28, lines 41-57) [The communication

system supports mailing list such as a group code to send messages to all the

recipients].


Regarding **claim 6**, Cohn discloses unique methods for alternate messaging

protocols (column 8, lines 1-44) [The communication system includes protocol

capabilities such that messages sent from one media can be received in different

media].

Regarding **claim 7**, Cohn discloses multiple industry uses as described in some

examples given in "Examples Of Uses" section of this document (column 7, lines 15-42)

[The communication system operates to process and route communication traffic from a

wide variety of messages sources to a wide variety of message destinations].

Regarding **claim 10**, Fortman teaches a two-way communication include unique

methods for the recipient to acknowledge receipt of the message and/or respond back

by using any of the messaging devices (column 8, lines 6-30) [The subscriber is able to

respond to the message retrieved as an acknowledgement of receiving the message by

the system providing a two-way communications to the subscribers].

Regarding **claim 16**, Cohn discloses automatic escalation of delivery of

messages include unique methods to accept specification of escalation time intervals

(column 19, lines 32-46).

Regarding **claim 17**, Cohn discloses automatic escalation of delivery of

messages include unique methods to broadcast messages to all the devices in the

hierarchy if the message is designated as urgent (column 25, lines 25-36).

Regarding **claim 18**, Fortman teaches scalability, efficiency and reliability

comprise unique modular techniques of creating the various methods called the engines

(column 7, lines 5-19) [The universal receives the messages from the caller for

scalability, sends messages to service provider to analyze the messages for caller

information for efficiency and notifies the subscriber in its profile format for reliability].


Regarding **claim 19**, Fortman teaches scalability, efficiency and reliability

comprise unique method to allow for replication of these engines on a given system

(column 7, lines 5-19) [The universal receives the messages from the caller for

scalability, sends messages to service provider to analyze the messages for caller

information for efficiency and notifies the subscriber in its profile format for reliability].


Regarding **claim 20**, Cohn discloses unique methods of using a database as its

main technique for receiving, storing and forwarding messages and commands (column

8, lines 1-8).

4.      **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn in

Fortman and in further view of O'Neal (US 2001/0048735).


Regarding **claim 8**, Cohn and Fortman as applied to **claim 1** differ from **claim 8**

in that it fails to disclose implementing for automated messaging from various

enterprise-wide applications including but not limited to server applications client/server

applications, web browser based applications and direct interface from messaging

devices.

However, O'Neal teaches implementing for automated messaging from various

enterprise-wide applications including but not limited to server applications (¶ 0061, line

3 "via servers"), client/server applications (¶ 0077, line 10 "special client applications"),

web browser (¶ 0063, line 19 "a simple web browser") based applications and direct

interface from messaging devices (¶ 0042) [The computer provides the capability to

send either a voice format message or a text message over the telephone network].

It would have been obvious to one of the ordinary skill in the art at the time the

invention was made to use various enterprise-wide applications including but not limited

to server applications client/server applications, web browser based applications and

direct interface from messaging devices of O'Neal to modify the invention of Cohn and

Fortman.

The modification of the invention would offer the capability of various enterprise-

wide applications including but not limited to server applications client/server

applications, web browser based applications and direct interface from messaging

devices such as the subscriber would retrieve and send response to a message in a

format independent of the store or retrieve format.

5.     **Claims 9 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Cohn in Fortman and in further view of Pitcher (US 6,721,398).

Regarding **claim 9**, Cohn and Fortman as applied to **claim 1** differ from **claim 9**

in that it fails to disclose handling any and all messaging devices such as, but not

limited to wireless telephones, wired telephones, pagers, palmpilots, fax machines, e-

mails.

However, Pitcher teaches handling any and all messaging devices such as, but

not limited to wireless telephones, wired telephones, pagers, palmpilots, fax machines,

e-mails (column 4, lines 10-15 and column 7, lines 1-16).

It would have been obvious to one of the ordinary skill in the art at the time the

invention was made to use handling any and all messaging devices such as, but not

limited to wireless telephones, wired telephones, pagers, palmpilots, fax machines, e-

mails of Pitcher to modify the invention of Cohn and Fortman.

The modification of the invention would offer the capability of handling any and all

messaging devices such as, but not limited to wireless telephones, wired telephones,

pagers, palmpilots, fax machines, e-mails such as the subscriber would retrieve and

send response to a message in a format independent of the store or retrieve format.

Regarding **claim 15**, Pitcher teaches automatic escalation of delivery of

messages include unique methods to accept a hierarchy of messaging devices to be

used for automatic message delivery escalation (column 8, lines 50-53).

6.      **Claims 11-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cohn in Fortman and in further view of Picard et al. (US 6,233,318).

Regarding **claim 11**, Cohn and Fortman as applied to **claim 2** differ from **claim

11** in that it fails to disclose a two-way communication include unique methods for the

system to accepts and process the responses and verify authorization before accepting

the responses.

However, Picard teaches a two-way communication include unique methods for

the system to accepts and process the responses and verify authorization before

accepting the responses (column 15, lines 61-67).

It would have been obvious to one of the ordinary skill in the art at the time the

invention was made to use a two-way communication include unique methods for the

system to accepts and process the responses and verify authorization before accepting the responses of Picard to modify the invention of Cohn and Fortman.

The modification of the invention would offer the capability of a two-way communication include unique methods for the system to accepts and process the responses and verify authorization before accepting the responses such as the subscriber would retrieve and send response to a message in a format independent of the store or retrieve format.

Regarding **claim 12**, Picard teaches a two-way communication include unique methods of delivering the responses back to the appropriate destinations (column 9, lines 40-67) [Responses are returned to a requester in MIME compatible format].

Regarding **claim 13**, Picard teaches a two-way communication include unique methods to receive, to verify authorization and accept commands from authorized recipients (column 15, lines 61-67).

Regarding **claim 14**, Picard teaches a two-way communication include a capability of execution of commands on the specified host (column 10, line 66 to column 11, line 3).

## Response to Arguments

7.    Applicant's arguments with respect to **claims 1-20** have been considered but are moot in view of the new ground(s) of rejection.


8.    The application has been given the priority date of 04/10/2000 as claimed. The Segur prior art has been cited because of the filing date of the patent, which is 1/21/1997 not because of the issue date (04/03/2001) argue by the applicant. All the references used in the office action are based on the filing dates not the issue date.


9.    Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions.  Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.


10.    This action is a **final rejection** and is intended to close the prosecution of this application.  Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed.  The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

### *Conclusion*

11.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

g.g.
April 28, 2004

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